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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,598	09/10/2003	Miri Seiberg	JBP-430-CIP1	5368

27777 7590 06/08/2005

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EXAMINER
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GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/659,598

Applicant(s)

SEIBERG ET AL.

Examiner

Shirley V. Gembeh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/25/2005, 7/12/04, 7/19/04, 7/19/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 11-62 are pending

#### **Election**

Applicants' election of group 1 claims 1-10 in reply filed on Nov. 22, 2004 is acknowledged.

Applicant's election with traverse of Group 1, Claims 1-10 in the reply filed on November 22, 2004 is acknowledged. The traversal is on the ground(s) that there is no undue burden to the examiner and that the same search for Group 1 can also be used for the other groups. This is not found persuasive because there are different method steps employed for groups II-IV.

Claims 11-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions. The requirement is still deemed proper and is therefore made FINAL.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 10 are provisionally rejected under the judicially created doctrine of double patenting over claim 1 of copending Application No. 10,903,702. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claims	Current Application	Patent Application Publication 10/903,702
1	Describes: a method of treating acne comprising topically administering to a mammal in need of treatment therefor an effective amount of a composition comprising a compound selected from the group consisting of synthetic retinoids, natural retinoids and retinol and a nondenatured botanical extract having trypsin-inhibiting activity. <b>Comment:</b> Although the claim does not say the treatment of acne it does describe PIH to result from healed acne lesions, and that it appears in areas affected by acne.	Claim 1 claims a method of treating post inflammatory hyperpigmentation (PIH) comprising topically administering to a mammal in need of treatment therefor an effective amount of a composition comprising salicylic acid, a compound selected from the group consisting of synthetic retinoids, natural retinoids and retinol and a nondenatured botanical extract having trypsin-inhibiting activity. Although the claim does not say the treatment of acne it does describe PIH to result from healed acne lesions, and that it appears in areas affected by acne.
2	Word for word identical to claim 2	A method according to claim 1 where in said retinoid is selected from the group consisting of a synthetic retinoid, retinoic acid esters of retinoic acid and retinol.
3	Word for word	A method according to claim 2 wherein said retinoid compound is retinoic acid
4	Word for word	A method according to claim 2 wherein said retinoid compound is retinol

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5	Word for word	A method according to claim 1 wherein said nondenatured botanical extract is selected from the group consisting of the botanical families leguminosae, solananceae, gramineae, cucurbitaceae and a mixture thereof.
6	Word for word	A method according to claim 1 wherein said botanical family is leguminosae.
7	Word for word	A method according to claim 6 wherein said legume is selected from the group consisting of nondenatured soybean extract, nondenatured limabean extract, nondenatured blackbean extract and mixtures thereof.
8	Word for word	A method according to claim 7 wherein said extract is selected from the group consisting of: fractions nondenatured soybean extract, nondenatured limabean extract, nondenatured blackbean extract and mixtures thereof.
9	Word for word	A method according to claim 8 wherein said extract is selected from the group consisting of: fractions nondenatured soybean milk nondenatured limabean milk, nondenatured blackbean milk, nondenatured soybean extract, nondenatured limabean extract, nondenatured blackbean extract nondenatured soybean paste nondenatured limabean paste, nondenatured blackbean paste and mixtures thereof.

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No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembeh whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG  
05/13/2005

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